

REMARKS

Claims 1, 2, 4-19 and 21-34 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1, 2, 4-19 and 21-34. These editorial amendments were made for reasons of precision of language, consistency, and to broaden the scope of the claims. The amendments do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to were not made for reasons of patentability.

Further, claim 1 has been amended to incorporate the subject matter of claim 3 and claim 18 has been amended to incorporate the subject matter of claim 20, consequently claims 3 and 20 have been canceled. Since the subject matter of claims 3 and 20 were previously before the Examiner, no new matter is raised.

Preliminary Matters

As preliminary matters, Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority documents was received. In addition, Applicant thanks the Examiner for accepting the drawings filed on August 30, 2002 and for initialing the references listed on Form PTO-1449 submitted with the Information Disclosure Statement filed on August 30, 2002.

Summary of the Office Action

Turning to the merits of the Office Action, claims 1-34 are rejected under 35 U.S.C. § 103(a).

Claim Rejections - 35 USC § 103

In particular, claims 1-12, 17-29, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeView.com's Search Service <http://web.archive.org/web/19970116182733/http://www.collegeview.com/>, hereafter referred to as ("CollegeView") and US Patent 5,659,742 to Beattie et al. (hereinafter "Beattie"). Applicant respectfully traverses this rejection in view of the following remarks.

Of the rejected claims only claims 1 and 18 are independent. This response initially focuses on these independent claims. Independent claims 1 and 18, among a number of unique features, includes some variation of generating an electronic leaflet from electronic information using designation of various kinds of selection items, organizing the generated electronic leaflet into a predetermined layered structure, and storing the structured electronic leaflet in a data base.

To begin, the Examiner alleges that CollegeView teaches generating the electronic leaflet. In addition, although the Examiner acknowledges that CollegeView does not teach or suggest creating a layered structure for the electronic leaflet and storing the structured leaflet in a database, the Examiner alleges that Beattie cures this deficiency (see pages 3-4 of the Office Action). Applicant respectfully disagrees.

CollegeView is a free online college search service, which provides the profiles of thousands of universities and colleges, virtual tours, electronic applications, financial aid information, and career planning tools (page 1). CollegeView, however, only teaches that for each college, CollegeView online will provide 10 pages: a welcome page, a page of general information, a page on student body, a page on major and degrees, a page on student life, a page

on athletics, a page on special services, a page on admissions, a page on financial info, and a page on transfer and foreign students (page 6). In CollegeView, however, there is no teaching or suggestion of generating an electronic leaflet. CollegeView only teaches that CollegeView online has ten pages but there is no teaching or suggestion of how these ten pages for each university is obtained. That is, there is no teaching or suggestion of how these ten pages are organized and/or stored.

Moreover, CollegeView, as acknowledged by the Examiner, fails to teach or suggest structuring the electronic information and storing the structured information into the database. The Examiner alleges that Beattie cures the deficient teachings of CollegeView. Beattie, however, does not teach or suggest organizing the electronic leaflet into a predetermined layered structure and storing the layered structure into the database.

That is, Beattie does not cure the deficient teachings of CollegeView. Beattie teaches a method of storing multi-media information in a retrieval system, which has a database for retrieval of the input information in response to a query (see *Abstract*). In Beattie, a plurality of document records, each of which is representative of at least one textual document, are stored, and a plurality of multi-media records, each of which is representative of at least one of multi-media file, are also stored. A single search query corresponding to the search topic is received. Based on the query, an index database (with plurality of search terms) is searched to simultaneously identify document records and multi-media records related to the single search query via a table which identifies the correlation between records and various search terms (col. 3, line 59 to col. 4, line 31).

Beattie, however, only teaches retrieving a document from a document database and retrieving the search terms from the index document database. In Beattie, there is no teaching of organizing information into a predetermined layered structure and no storing of the structured information into the database. Instead, in Beattie, a table is provided to correlate a record with a search term. In short, Beattie does not cure the deficient teachings of CollegeView.

Moreover, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. A critical step in analyzing the patentability of claims pursuant to section 103(a) is *casting the mind back to the time of invention*, to consider the thinking of one of ordinary skill in the art, *guided only by the prior art references and the then-accepted wisdom in the field*. See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)), (emphasis added). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)), (emphasis added). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish

obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, **the showing of combinability, in whatever form, must nevertheless be “clear and particular”**. *Winner International Royalty Corporation v. Ching-Rong Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000), (emphasis added). In the present case, there is no motivation to combine the references in the manner suggested by the Examiner.

In particular, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine the references so as to enable desirable searching and retrieval of multimedia leaflet information (see page 4 of the Office Action). CollegeView, however, teaches that the user will be provided with information about colleges that match the user criteria. The information about colleges can be viewed by CollegeView online, which provides ten pages of information about the college including link to the colleges' home page and InfoZap to request written materials from the college of interest via email (pages 4 and 5). That is, the searching necessary for the CollegeView Search Engine is already being performed. There is no motivation or suggestion to replace and/or to somehow attempt to combine the searching engine of CollegeView with the one taught by Beattie.

Therefore, generating an electronic leaflet from electronic information using designation of various kinds of selection items, organizing the generated electronic leaflet into a predetermined layered structure, and storing the structured electronic leaflet in a data base, as set forth in claims 1 and 18 are not suggested or taught by the combined teachings of CollegeView and Beattie, which lack generating electronic leaflet, organizing the electronic leaflet into a predetermined layered structure and storing the structured electronic leaflet in a database. For at least these exemplary reasons, claims 1 and 18 are patentable over the combined teachings of CollegeView and Beattie.

Further, claims 1 and 18 have been amended to recite the subject matter of former claims 3 and 20 which is not disclosed in the cited art. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 1 and 18, and their dependent claims 2, 4-17, 19, 21-34.

Claims 14-16 and 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CollegeView and Beattie in view of U.S. Patent 5,794,159 to Herr-Hoyman et al. (hereinafter "Herr-Hoyman"). Claims 14-16 and 31-33 depend on claims 1 and 18, respectively. Applicant has already demonstrated that the combined teachings of CollegeView and Beattie do not teach or suggest unique features recited in the independent claims 1 and 18. Herr-Hoyman is only cited for its teaching of charging for uploading pages (col. 4, lines 9 to 17).. Clearly, Herr-Hoyman does not cure the deficient teachings of CollegeView and Beattie. Therefore, claims 14-16 and 31-33 are patentable at least by virtue of their dependency on the independent claims 1 and 18, respectively.

Moreover, with respect to dependent claim 16, the Examiner alleges that CollegeView teaches “charging the user according to the conditions of access to a chargeable electronic leaflet,” (see page 11 of the Office Action). Applicant respectfully submits that this position is technically inaccurate.

CollegeView teaches that it provides a free online college search service (page 1). Hence, clearly CollegeView cannot teach or suggest charging the user. Beattie and Herr-Hoyman fail to cure the deficient teachings of CollegeView. Beattie only teaches providing accounting and subscriber services. With respect to the subscriber services, Beattie teaches registering new users in the accounting database (col. 10, line 65 to col. 11, line 15) but the accounting services are only mentioned in passing and no details are provided. That is, Beattie fails to teach or suggest charging the user. Moreover, Beattie fails to teach or suggest charging the user according to the conditions of access to a chargeable electronic leaflet. In Beattie, no teaching or suggestion is provided as to how and whether the user is charged. Herr-Hoyman also fails to cure the deficient teachings of CollegeView and Beattie in that Herr-Hoyman only teaches charging the author, the person uploading pages (col. 1, lines 28 to 48), and not the reader.

In short, the combined teachings of CollegeView, Beattie, and Herr-Hoyman fail to teach or suggest “charging the user according to the conditions of access to a chargeable electronic leaflet,” as set forth in the dependent claim 16. For at least this additional reason, Applicant respectfully submits that claim 16 is patentable over the combined teachings of CollegeView, Beattie, and Herr-Hoyman.

Finally, the Examiner rejected claims 13 and 30 under 35 U.S.C. § 103(a) as being unpatentable over CollegeView and Beattie in view of U.S. Patent 6,347,943 to Fields et al. (hereinafter “Fields”). Claims 13 and 30 depend on claims 1 and 18, respectively. Applicant has already demonstrated that the combined teachings of CollegeView and Beattie do not teach or suggest unique features recited in the independent claims 1 and 18. Fields is only cited for its teaching of assessment mechanism. Clearly, Fields does not cure the deficient teachings of CollegeView and Beattie. Therefore, claims 13 and 30 are patentable at least by virtue of their dependency on the independent claims 1 and 18, respectively.

Moreover, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. In particular, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine the references in order to allow the user to select a customized course of instructions based on assessment of each user’s knowledge of a particular topic (see page 12 of the Office Action). CollegeView, however, only relates to selecting colleges (page 1, 2, and 4) and Beattie only relates to storing and retrieving multi-media information. Fields provides a system for creating individualized courses based on the assessment (see *Abstract*). It is unclear, however, why one of ordinary skill in the art would include a customized course when the user attempts to pick a college. In other words, it is unclear how having a customized course of instructions being provided in response to an assessment would help the user to pick a college. That is, Applicant respectfully submits that one of ordinary skill in the art concerned with college searches would not have been motivated to provide a user with customized course of

instructions, as suggested by the Examiner. For at least this additional reason, Applicant respectfully submits that dependent claims 13 and 30 are patentable over the combined teachings of CollegeView, Beattie, and Fields.

New Claims

In order to provide more varied protection, Applicant adds claims 35. Claim 35 is patentable at least by virtue of its dependency on claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

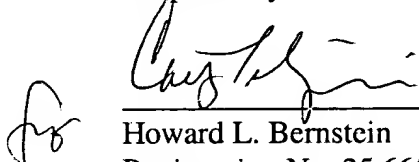
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Respectfully submitted,

 #449,766
Howard L. Bernstein
Registration No. 25,665

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